Docket No.: 07238/000J393-US0
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Peter J. Stappers

Application No.: 09/879,247   Confirmation No.: 2263

Filed: June 7, 2001   Art Unit: 2173

For: METHOD AND ELECTRONIC DATABASE   Examiner: M. Roswell
     SEARCH ENGINE FOR DISCLOSING AN
     ELECTRONIC DATABASE

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

      Appellants submit this reply brief in accordance with 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed February 7, 2006.

REMARKS

      The combination of MacCuish, Tachibana, and Osga results in a system that fails to have an icon appear at a position selected by a control means when there is an element in a database having a corresponding distance to database elements for which icons are already displayed elsewhere on the display unit.. Thus, combining MacCuish, Tachibana, and Osga does not result in the claimed invention.

      The Examiner acknowledges MacCuish's narrow disclosure and that MacCuish fails to disclose "the control means to select a position on the display unit that upon selection displays or

removes an icon related to a database element where its degree of dissimilarity to other icons corresponds with the distances between the icons." The Examiner further acknowledges that MacCuish fails to disclose "the mutual positioning of icons on the display in concurrence with the dissimilarity of the elements from the database in order to optimize the usable display area on the display unit." (Detailed Action, page 2.) The Examiner cites Tachibana (column 2, lines 42-52, and column 1, lines 1-5) as disclosing those features acknowledged to be missing from MacCuish.

However, the Examiner also acknowledges that the combination of MacCuish and Tachibana fails to disclose, or suggest, "the display or removal of an icon related to a database element upon the selection of an arbitrary position on the display." (Detailed Action, page 3.) The Examiner relies on Osga as disclosing "the selection and manipulation of an object on the display based on the selection of an arbitrary position by the user, based on the distance of a cursor to an object, as shown at col. 4, lines 40-53." (Detailed Action, page 3) The Examiner contends that it would have been obvious to a person of ordinary skill in the art to combine MacCuish, Tachibana, and Osga to achieve the invention of claims 1-8.

Appellant submits that Tachibana, column 2, lines 42-52, discloses an apparatus that draws icons corresponding to objects, where the correlation between objects is taken into account in computing the correlated positions of the icons. This passage describes in general terms the embodiment of Tachibana, Fig. 4, which is explained at column 6, line 23-45. Column 6 clearly discloses that **Tachibana's user interface displays elements at varying distances based on their correlation from a root element**. Tachibana discloses displaying icons indicating hierarchical levels, where "the icon indicating the root of the first hierarchical level is a currently regarded node, and is positioned in the center . . . ." (Tachibana, column 6, lines 24-26.) Tachibana discloses that **the other icons are positioned relative to the icon which indicates "the root of the first hierarchical level."**

As recited in the claims, the present invention selects any <u>arbitrary position</u> on the display unit. Further, the user interface, depending on the control means, displays or removes an icon that relates to any possible element of the database of which the selected <u>arbitrary position</u>

corresponds to the degree of dissimilarity with the other elements. In contrast to disclosing displaying an icon at any arbitrary position on the display unit, Tachibana discloses "an icon indicating the root of the first hierarchical level . . . positioned in the center" and that other icons are positioned relative to this root icon. Tachibana does not disclose, or suggest, "an arbitrary position . . . selected on the display unit" and the display of "the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit," as recited in the present claims.

Appellant submits that the disclosure of Osga, column 4, lines 40-53, has no bearing on the patentability of independent claims 1 and 5. Osga in general is directed to determining if a cursor is located over a position on a display that corresponds to an object that a user wishes to select. Osga discloses a solution to the problem where a user must move his cursor to an object to be selected, estimate that the cursor appropriately overlaps the limited area directly over the object, and then must make a selection action. (Osga, column 1, lines 53-66.) Osga merely discloses a scheme to highlight an object that is closest to the actual cursor placement selected by the user.

In contrast, the present invention displays icons (which represent database elements) at positions **selected by a control means**, where the **distance of the icons on the display unit corresponds with the degree of dissimilarity of the database elements** being represented. Claim 1 recites:

> [a] control means [that] selects any arbitrary position on the display unit and [a] user interface [that] displays or removes an icon that relates to an element of the database and of which the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit, corresponds with the distance taken up by the selected position in relation to the icons displayed elsewhere on the display unit.

Under the present invention, an icon appears at the position selected by the control means when there is an element in the database having a corresponding distance to database elements for which icons are already displayed elsewhere on the display unit. Appellant submits that the present invention is significantly different than the system that results from the combination

of MacCuish, Tachibana, and Osga. Thus, the combination of MacCuish, Tachibana, and Osga does not result in the claimed invention. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

CONCLUSION

For all of the reasons set forth above, the rejections of claims 1-8 should be reversed. Appellants respectfully request that the application be remanded to the Primary Examiner with an instruction to withdraw the 35 U.S.C. § 103(a) rejections, and pass the case to allowance.

Favorable consideration of this Reply Brief is respectfully requested.

The Examiner is hereby authorized to charge any additional fees associated with this reply to our Deposit Account No. 04-0100.

Respectfully submitted,

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